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September 6, 2005

FAX#: 571-273-8300 Central Fax Location **PAGES (including Cover Sheet):** 5**TO:** Office of Petitions**SENDER:** Jonathan O. Scott, Reg. 39, 364

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RE: Application No. 09/702,289

Filing Date: October 20, 2000

Inventor(s): Chen et al.

Title: TRACKING AND REPORTING OF COMPUTER VIRUS INFORMATION

Docket No.: TRNDP004

MESSAGE: Attached are the following:

- 1) Petition for Withdrawal of Final Rejection Under 37 CFR 1.181 and 1.182
(4pgs)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Chen et al.

Attorney Docket No.: TRNDP004

Application No.: 09/702,289

Examiner: KHOSHNOODI, Nadia

Filed: October 30, 2000

Group: 2133

Title: TRACKING AND REPORTING OF
COMPUTER VIRUS INFORMATION

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to the United States Patent and Trademark Office, Attention: Office of Petitions at facsimile number 571-273-8300 on September 06, 2005.

Signed: _____

Ryan Eachus

PETITION FOR WITHDRAWAL OF FINAL REJECTION
Under 37 C.F.R. § 1.181 and 1.182

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Status of Application

A first Office action by Examiner Todd Jack was mailed February 6, 2004 and rejected all claims 1-22; Applicant filed a Reply to that action on May 6, 2004. Evidently the case was reassigned as a final Office action was prepared by Examiner Khoshnoodi and mailed May 4, 2005, again rejecting all claims. Applicant held a telephone interview with Examiner Khoshnoodi on August 17, 2005 and filed a Reply after Final by facsimile on August 18, 2005.

Applicant is making a good-faith effort to resolve this issue of the finality of the previous Office action. Applicant held a telephone interview with the Examiner on August 17, 2005 in which the finality of the previous Office action was discussed; Applicant then filed a Reply after Final on August 18 requesting reconsideration of that final action. Applicant has just learned that the Examiner will not reconsider the decision and has thus filed this petition.

Therefore, Applicant requests that the Director use his discretion to deem that this petition is not untimely.

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The previous Office action was made final because "Applicant's amendment necessitated the new ground of rejection." Applicant respectfully requests that the finality of that action be withdrawn for the following reasons.

I. Applicant's Claim Amendments Did Not Necessitate the New Ground of Rejection

MPEP 706.07(a) states that a second action on the merits shall be final, except where the Examiner introduces a new ground of rejection that is not necessitated by applicant's amendment of the claims. Applicant's minor amendments did not introduce a new limitation that required the Examiner to undertake a new search. In fact, the Examiner was obligated to introduce a new ground of rejection because the first Office action did not adequately reject the claims based on the two original references. In other words, the new ground of rejection in the supposedly final Office action was necessitated by deficiencies in the first Office action.

The first Office action is deficient in that it did not properly reject claim 1 or did not allege that each limitation of the claim was present in the cited reference. Taking claim 1 for example, the first Office action alleges that the second element ("at least one antivirus scanning server") is present in *Hailpern et al.* (first Office action, page 2). But, the final Office action retreats from that position and suddenly claims that this second element is not disclosed in *Hailpern et al.* (final Office action, page 3). The final Office action then introduces a new reference, *Tso*, and a new ground of rejection and alleges that this second element is present in *Tso*.

Further, the first Office action does not allege that the third element ("a scan log of information") is present in either of the cited references. The final Office action agrees with this position and states that this third element is not disclosed in *Hailpern et al.* The final Office action then introduces a new ground of rejection and alleges that this third element is present in *Tso*. Applicant can also point out further deficiencies in the first Office action regarding the fourth element of claim 1 and corresponding steps of claim 12.

Because the first Office action was deficient in that it did not properly reject claim 1 (in addition to other claims), the Examiner was obligated to undertake a new search (finding the *Tso* reference) in order to properly reject the claims. Thus, the new ground of rejection presented in the final Office action was not necessitated by Applicant's minor amendments to the claims but was necessitated because the first Office action was deficient.

BEST AVAILABLE**II. Applicant's Claim Amendments Were Minor**

Looking at the claims from a common sense point of view, Applicant submits that the claims were not amended in any way that would cause a reasonable Examiner to feel obligated to undertake a completely new search.

Claim 1 was amended to add the phrase "from said client computers" to the fourth element, and claim 12 was amended to add the phrase "information from said client computers" to the fourth step. But, these added phrases do not add new limitations to the claim. The limitations clarified by the addition of these phrases were already present in the claims and were supposedly searched during the first Office action.

Before amendment, claim 1 required in its third element "a scan log of information which is sent back from each client user." Thus, the scan log is sent back from the client computer of each user. The fourth element makes it clear where the scan log of information is going: before amendment, the fourth element required "a virus tracking server for receiving the scan log information." Thus, the virus tracking server receives the scan log information which is sent back from each client user having a client computer. This limitation of the claim is quite clear upon a reading of the claim before amendment. Applicant added the phrase "from said client computers" in order to assist with an understanding of the claim and to make it crystal clear where the scan log is coming from, but the phrase certainly did not add a new limitation to the claim. Claim 12 was modified in a similar fashion and likewise had no new limitation added to it.

It is the undersigned's understanding that the Examiner is taking the position that any amendment to a claim (even a trivial amendment) must necessarily result in a second Office action being made final. But, no case law or Office rule supports that position. A trivial clarifying amendment that does not add a new limitation certainly does not require that the Examiner undertake a new search.

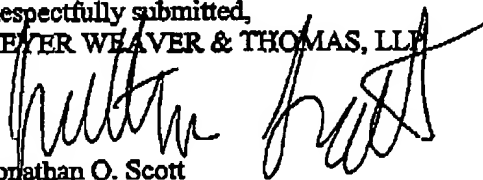
In conclusion, it is respectfully submitted that the most recent Office action cannot be made final because the minor clarifying amendments made by Applicant did not introduce any new features or limitations requiring the Examiner to perform a new search. In fact, the Examiner was required to perform a new search and introduce a new ground of rejection because

the first Office action did not adequately reject the claims. Therefore, Applicant submits that the final rejection was premature and requests that the finality of that rejection be withdrawn.

Please charge the required fees, or any additional fees required to facilitate filing the enclosed Petition, to Deposit Account No. 500388 (Order No. TRNDP004).

If it is determined that any other fees are due, the Commissioner is hereby authorized to charge such fees to Deposit Account 500388 (Order No. TRNDP004).

Respectfully submitted,
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